UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte WILLIAM Y. SUN

Appeal 2007-0692
Application 10/729,973
Technology Center 3700

ON BRIEF

Before MILLS, GREEN, and LEBOVITZ, *Administrative Patent Judges.*

LEBOVITZ, *Administrative Patent Judge.*

DECISION ON APPEAL

Claims 1 and 8 are on appeal. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

STATEMENT OF CASE

This appeal involves claims to a tongue stabilizer for a laryngoscope blade. Laryngoscopes are utilized by physicians to visualize the epiglottis (Specification 1). In an emergency situation where it is necessary to establish an artificial airway, a laryngoscope may be used "to keep the tongue out of the way in order to visualize the epiglottis so that an endotracheal tube can be inserted into the trachea." (*Id.* at 1: 10-12.) This

process is called "intubation." "The problem is that all the laryngoscope blades on the market now are narrow and can hold only approximately half of the tongue, so that it is very hard to make the tongue stay on the laryngoscope blade with any degree of stability." (*Id.* at 1: 13-15.) The specification describes the invention as a "tongue holder or stabilizer" which can be attached to a laryngoscope blade to control the tongue as the intubation process is performed (*Id.* at 2-3).

Claims 1-17 are pending (Br. 4). Claims 1 and 8 stand finally rejected as anticipated under 35 U.S.C. § 102(b) by Panduit (Product Bulletin, "ABM112 Adhesive Backed Cable Tie Mount," pp. 28-29, 1999) (*Id.*). Claims 2-7 and 9-17 contain allowable subject matter, but are objected to as being dependent on rejected claim 1 (*Id.*).

Claim 1 is the broadest claim on appeal. It reads as follows:

> 1. A tongue stabilizer for a laryngoscope blade comprising:
>
> a tongue-engaging plate having a top surface, a bottom surface, a forward end, a rear end, a first side, a second side and a central area;
>
> a foam strip support having a top surface and a bottom surface with said foam top surface attached to said tongue engaging plate bottom surface between said forward end and said rear end and between said first side and said second side;
>
> a pressure-sensitive adhesive having a top surface, attached to and extending along said foam support bottom surface, and a bottom surface, available for attaching said tongue stabilizer to a laryngoscope blade.

ISSUE ON APPEAL

Claim 1 is drawn to a "tongue stabilizer for a laryngoscope blade" that contains three elements: 1) a "tongue-engaging plate"; 2) a "foam strip

support" attached to the plate; and 3) a "pressure-sensitive adhesive" attached to the foam support.

The Examiner contends that Panduit's cable tie mount comprises top surfaces which are "fully capable of engaging a tongue," meeting the claimed requirement of a "tongue-engaging plate." (Answer 5.) Appellant contends that Panduit does not disclose a structure that can be utilized to support and stabilize a tongue, the function required by the tongue-engaging plate (Br. 9-10).

The issue in this appeal is whether Panduit describes a device which comprises a tongue-engaging plate as required by claim 1, anticipating the claim under 35 U.S.C. § 102(b). This issue turns on the proper interpretation of the phrase "tongue-engaging plate" which is recited in claim 1.

CLAIM INTERPRETATION

In comparing a claim to the prior art, the first step is to interpret the meaning of the words in the claim. This is essential because it is the claim language which determines a claim's proper scope. In this case, the dispute between the Examiner and the Appellant rests on the proper interpretation of "tongue-engaging plate" as recited in claim 1.

During patent examination, claims are given their broadest reasonable interpretation read in light of the specification as they would be understood by one of ordinary skill in the art. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Crish*, 393 F.3d 1253, 1256, 73 USPQ2d 1364, 1367 (Fed. Cir. 2004). Using this principle as a guide, we turn to the claim interpretation issue before us.

The claimed invention is drawn to a "tongue stabilizer for a laryngoscope blade." It comprises a "tongue-engaging plate." We understand the term "engaging" in the context of the claim and specification to mean that the plate "comes into contact with" the tongue. *See Primos Inc. v. Hunter's Specialties Inc.*, 451 F.3d 841, 847-48, 79 USPQ2d 1129, 1134-35. When in contact with the tongue, the plate is used "to confine the tongue and prevent it from slipping and obstructing and/or obscuring the throat passage." (Specification 5: 3-5.) This contact is necessary to "support" (*Id.* at 4:16) and "confine" the tongue during an intubation procedure (*Id.* at 5: 3-5; 6: 4-7).

In addition to confining the tongue, the tongue-engaging plate also "holds" the tongue. As pointed out in the "Description of Related Art," prior art laryngoscopes "are narrow and can hold only approximately half of the tongue, so that it is very hard to make the tongue stay on the laryngoscope blade with any degree of stability." (*Id.* at 1: 13-15.) To solve this problem, Appellant provides a tongue-engaging plate which, when attached to the laryngoscope, holds the tongue on its surface so it does not slip off and obscure the throat passage (*Id.* at 5). Preferred shapes are that of a spoon or a concave upper surface "to cradle the tongue." (*Id.* at 4: 16-17.)

Giving "tongue-engaging plate" its broadest reasonable interpretation as it would be understood by the skilled worker in view of the specification, we interpret it as a structure which, when attached to a laryngoscope blade and in contact with the tongue, must be capable of confining and holding the tongue on its surface.

THE PRIOR ART

Panduit discloses an adhesive-backed cable tie mount that is backed with a pressure-sensitive foam tape adhesive (Answer 4; Panduit at 29). The mount comprises: a raised open bridge-like structure for inserting wires, a foam strip support (part of the pressure-sensitive adhesive tape), and a pressure sensitive adhesive tape which is used to attach the mount to a surface (*Id.*). The opening in the mount is "to secure wire bundles or other light objects to smooth surfaces." (Panduit at 29.)

DISCUSSION

An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed in the prior art and that such existence would be recognized by persons of ordinary skill in the field of the invention. *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

The illustration of the cable tie mount in Panduit shows that it comprises two top surfaces attached to the self-adhesive form tape: an upper raised platform surface which lies on a wider bottom surface base. (*See* Reply Br. 9.) The raised platform is a bridge that forms an opening through which wires are inserted (Panduit at 28). The Examiner asserts that the top surfaces of the mount meet the claimed requirement of a tongue-engaging plate (Answer 5).

We do not agree. The "tongue-engaging plate" is required to confine and hold the tongue when in contact with it. We are not persuaded that the

skilled worker would have recognized the two-tiered top surface structure of Panduit's cable mount as a "tongue-engaging plate" which is capable of performing these functions. The Examiner asserts that "the top surfaces of the plates are fully capable of engaging a tongue." (Answer 5.) However, the dispositive issue is not whether the cable mount is capable of contacting ("engaging") the tongue, but whether it can confine and hold it on its top surface. The Examiner provides no evidence to support the position that the cable mount's two-tiered top surface would be recognized as capable of performing this function by persons of ordinary skill in the field of the invention.

In reaching this determination, we have interpreted the "tongue-engaging plate" to be more than a statement of purpose or intended use of the claimed device, but also to require that the plate is able to confine and hold the the tongue in order to control it during an intubation procedure. In other words, we interpret structure from it. The specification describes this structure generally as an "elongated" plate having preferred spoon or concave shapes (Specification 4: 14-17) to hold the tongue in place. The skilled worker would not have *reasonably* interpreted the tongue-engaging plate so broadly that it could cover the two-tiered cable mount surface described by Panduit. Yes, Panduit's mount could be adhesively attached to a laryngoscope blade, inserted into the mouth, and placed in contact with the tongue. But, we agree with Appellant that there is nothing about its upper surfaces that would reasonably suggest it could be used to hold the tongue, rather than damaging and deflecting it from the mount surface (Br. 10). The purpose of giving claims their broadest reasonable interpretation is to reduce

"the possibility that claims . . . will be given broader scope than is justified" by the prior art. *In re Bigio*, 381 F.3d 1320, 1324, 72 USPQ2d 1209, 1210-11 (Fed. Cir. 2004) (internal citations omitted). It is not an exercise in stretching the interpretation of a claim – far beyond what would be reasonably understood by the skilled worker in the light of the specification – to read on a prior art structure which could possibly, but not reasonably, be covered by it. The rejection of claims 1 and 8 is reversed.

REVERSED

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